

### STATUS OF CLAIMS

Claims 1, 3-4, 6-17 and 20 are now pending.

Independent Claims 1, 4 and 13 have been amended.

Dependent Claim 16 has been amended.

Dependent Claims 2, 5, 18 and 19 were cancelled previously without prejudice or disclaimer.

### REMARKS

This is a slightly revised version of a proposed Amendment after Final Rejection submitted January 2, 2007. Examiner Kramer sent an Advisory Action dated February 21, 2007. In it, the Examiner ruled that Independent Claim 20 was allowable but that the amendment of Claims 1, 4, 13 and 16 in the proposed Amendment would present new issues; hence, the Amendment after Final Rejection was not entered. Reconsideration and reexamination of this application is respectfully requested.

Applicant has amended Claims 1, 4, 13 and 16 in the same manner as proposed in the Amendment after Final Rejection. These Claims recite a feature which apparently convinced the Examiner to allow Claim 20. That feature is described in the following paragraphs.

In her comments concerning a prior rejection of Independent Claim 1, Examiner Kramer<sup>1</sup> inferred "between the lines" that the following feature was not found in the primary reference, U.S. Pat. No. 4,662,355 to Pieronne *et al.* ("Pieronne"): priming or air purging a shunt by a patient's own blood. Examiner Kramer ruled<sup>2</sup> however that Applicant's prior recitation in Claim

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<sup>1</sup> Examiner Kramer inherited this case (and the prior rejections) from Examiner Alexander, who left the Patent Office, as mentioned in the Remarks of an Amendment filed July 25, 2006.

<sup>2</sup> See Paragraph 14 of the Final Office Action.

1 of "for priming the vent with blood flow from the patient" was merely a statement of intended use; hence, it was not given any patentable weight. Claim 1 is an apparatus claim.

By this Amendment, Applicant now has incorporated that functional language into a means clause in 1(b)(ii), which reads: "... a sealing means for selectively opening and closing the vent for priming the shunt with the patient's own blood to remove [[by removing]] air from the shunt...". Since a proper means clause is defined as means plus function, this change should be acceptable and make Claim 1 allowable without any additional search.

Allowed Independent Claim 20 is a method claim. It recites that "priming" feature in a proper manner. Subparagraph d. (previously presented) reads: "d. priming the first shunt with the patient's own blood to remove air;". This feature is apparently what Examiner Kramer deemed allowable in Claim 20.

Applicant has amended Independent Claim 4, an apparatus claim, to parallel the edits of Claim 1. Applicant has amended Independent Claim 13, a method claim, to parallel the prior language of Claim 20.

Applicant has also amended Dependent Claim 16 to recite priming a second shunt with the user's blood: "d. priming the second shunt with the patient's own blood to remove air;".

Applicant has also changed "the cannulae" to "respective cannulae" to overcome a § 112, second paragraph, objection in the Final Office Action.

Applicant hereby maintains its prior arguments, stated in its Amendment filed July 25, 2006. For example:

1. There is no teaching in any of the cited patents to combine them in the manners originally proposed by Examiner Alexander. Examiner Alexander had improperly relied on knowledge derived solely from

Applicant's own disclosure (*i.e.*, application) as the basis to combine those references. That type of hindsight rejection is frowned upon by the Board of Appeals and the Federal Circuit.<sup>3</sup>

2. Even if the proposed combination of patents was proper, Examiner Alexander admitted that those patents do not teach some claimed features. To overcome that, Examiner Alexander basically stated, "it would seem" obvious that someone skilled in this field could fill in the gaps. That is the epitome of hindsight rejections.

The remaining pending claims are Dependent Claims 6-12 and 14. Each is allowable, as it depends from clearly allowable Independent Claim 4 or 13 discussed above. Each is also self-explanatory, so no further detail is needed.

Applicant believes that its application is now in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued.

Respectfully submitted,

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<sup>3</sup> After the Final Office Action, the U.S. Court of Appeals for the Federal Circuit redefined its "motivation-suggestion-teaching" test for cases involving patents based on combinations. See *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, Fed. Cir., No. 06-1088, 10/3/06. The Federal Circuit quoted *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329 (Fed. Cir. 2006) to redefine this test: "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims."